

80521F-P  
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David L. Patton

A METHOD FOR PRINTING AND  
VERIFYING LIMITED EDITION  
STAMPS

Serial No. 09/534,433

Filed 23 March 2000

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Sir:

Group Art Unit: 3722

Examiner: Mark T. Henderson

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APPEAL BRIEF TRANSMITTAL

Enclosed herewith in triplicate is Appellants' Appeal Brief for the above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,

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Docket 80521F-P  
Customer No. 01333

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

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Sir:

**APPEAL BRIEF PURSUANT TO 37 C.F.R. 1.192**

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## **APPELLANT'S BRIEF ON APPEAL**

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 12, 14, 18-23, 25 and 29-34 which was contained in the Office Action mailed October 9, 2003.

A timely Notice of Appeal was mailed on January 5, 2004.

### **Real Party In Interest**

As indicated above in the caption of the Brief, Eastman Kodak Company is the real party in interest.

### **Related Appeals And Interferences**

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

### **Status Of The Claims**

Claims 12, 14, 18-23, 25 and 29-34 have been rejected and are appealed.

Appendix I provides a clean, double spaced copy of the claims on appeal.

### **Status Of Amendments**

All the amendments have been entered and claims stand as indicated in Appendix I.

### **Summary Of The Invention**

The present invention is directed to a limited edition official postal stamp as illustrated by Figure 1 of the present application and includes a first indicia 10 that identifies that the stamp 20 is a limited edition stamp. The invention also includes a second indicia 30 which is not visible under normal viewing conditions for confirming that the limited edition stamp is a valid limited edition official stamp. The second indicia which is not visible under normal viewing conditions, is not capable of being scanned for reproduction. The limited edition stamp may also have a third indicia used for identifying the printer or location where the limited edition official postal stamp was printed.

## Issues For Review By The Board

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether claims 12, 14, 18-23, 25 and 29-34 are patentable over Gasper et al. U.S. Patent 5,919,730 in view of St. Louis Post-Dispatch Article and further in view of Ottawa Citizen.

## Grouping Of Claims

Group I:	Claims 12, 14, 18, 23, 25, 29, 34
Group II	Claims 19, 20, 21, 22, 30, 31, 32, 33

## Arguments

### *The Rejection*

*Group I: Claims 12, 14, 18, 23, 25, 29, 34*

A. The Examiner, in the Official Action, rejected claims 12, 14, 18-23, 25 and 29-34 as being unpatentable over Gasper et al. in view of St. Louis Dispatch Article and further in view of the Ottawa Citizen.

The Examiner cites Gasper for disclosing a stamp or sheet of stamps comprising a first indicia identifying the document, a second indicia using ink that can be seen when viewed under UV or infrared light that is not visible under normal viewing conditions and is capable of being scanned for reproduction.

Applicant respectfully submits that the Gasper et al. reference is totally apart and distinct from the present invention. First, the Gasper et al. reference is directed to a media for restricting copying of a document that utilizes one or more microdots that are embedded in the document for providing a non-visual, but machine detectable mark or marks. The print disclosed in Gasper is not related in any way to that being an official postal stamp as taught and claimed by Applicant. Further, there is no teaching or suggestion of Gasper providing a limited edition official postal stamp as discussed in greater detail later herein. Furthermore, the present invention includes a second indicia for confirming that the limited edition official postal stamp is a valid limited edition postal stamp and that the second indicia is not capable of being scanned for reproduction.

The Examiner, in responding to some of Applicant's previous arguments, attempts to make the argument that the present invention is not restricted to limited edition postal stamps. In this regard there are at least two instances in independent claims 12, 23, and 34 which specifically set forth that the present invention is directed to a limited edition official postal stamp. In claims 12, 23, and 34, first line states that it is directed to a "limited edition official postal stamp". Also, in the third line of claims 12, 23 and 34, reference again is directed to providing indicia identifying that said limited edition official postal stamp as being a limited edition. Thus, there is at least two instances in each of the independent claims that clearly set forth that the present invention is directed to a limited edition official postal stamp.

Applicant respectfully submits that the limited edition official postal stamp has a clear and distinct meaning. The fourth noun definition of postal stamp as set forth in Webster's II New College Dictionary (copy attached as Exhibit A) states that a stamp is "[a] small piece of paper that is sold by a government for affixing to an article to be mailed". The Examiner attempts to make the argument that the present invention is not limited to postal stamps. Applicant respectfully submits that this is in clear contradiction to the clear meaning and language of the claims. The Examiner has used the definition of "stamp" in its broadest sense which is clearly contrary to the language and meaning set forth in the claims. The Gasper et al. reference is directed to a document having microdots thereon to indicate the ability to copy the document. A media to which the microdots are applied in Gasper et al. is not equivalent to a postal stamp as taught and claimed by Applicant. Therefore, it could not be a limited edition postal stamp as taught and claimed by Applicant. Thus, the Examiner has failed on at least these two points to teach or suggest the present invention.

The Examiner relies on the St. Louis Post-Dispatch Article (1993) and Ottawa Citizen disclosing an official limited edition stamp and limited edition postage stamp. First, Applicant would like to point out that these references are totally apart and distinct from the Gasper et al. reference. The St. Louis Post-Dispatch article is directed to what is typically referred to a fishing or hunting stamp and is not in any way directed to a postage stamp. As previously discussed, the Gasper reference is just directed to a media for restricting copying of a document. The two are totally unrelated to each other and one would not typically look to one to combine with the other. The Ottawa Citizen reference is the only

one of the three references that discloses a limited edition stamp, however, it fails to teach or suggest providing an indicia which is not visible under normal viewing conditions for confirming that the limited edition official postal stamp is a valid limited edition postal stamp which is not capable of being scanned for reproduction. Furthermore, the Ottawa Citizen article is also unrelated to either of the other two cited references. When patentability turns on a question of obviousness, the search for an analysis of the prior art includes evidence relevant to the finding whether there is a teaching, motivation or suggestion to select and combine the references relied on as evidence of obviousness. See *In re Lee* 277 Fed 3<sup>rd</sup> 1338, 61 USPQ 2<sup>nd</sup> 1430. As the Court also stated therein “teachings of references can be combined only if there is some suggestion or incentive to do so....only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references” (see *In re Lee* at page 1434). In the present invention the three cited references are all directed to totally apart and distinct aspects. There is no teaching in any of the references that would lead one to attempt to combine one with the other. The Gasper et al. reference is directed to restricting copying of a document by embedding microdots; the St. Louis Post-Dispatch Article is directed to a water fowl stamp; and the Ottawa Citizen is directed to a commemorative stamp. There is nothing in either of the references that would teach or suggest the combining of one with the other. Further, even if they are combined as suggested by the Examiner, they still fail to teach or suggest providing of the second indicia which is not visible under normal viewing conditions that the limited edition postal stamp is a valid limited edition postal stamp as previously discussed. The Examiner appears to argue that the microdots of the Gasper et al. reference are also believed to be of the non-visible type as set forth and claimed by Applicant. Applicant respectfully submit that the term “not-visible under normal viewing conditions” is sufficient to one of ordinary skill to understand what is being set forth. Further, Applicant would like to point out that Gasper et al. at column 6, lines 41-48 states:

“In practicing the invention the size of the microdots is chosen to be smaller than the maximum size at which individual microdots are perceived sufficiently to decrease the usefulness of the document when viewed under normal conditions of usage. The minimum size of individual microdots is chosen to be greater than or equal to the size at which the microdot pattern can be reasonably detected by document scanning devices.”

As can be seen, the Gasper et al. reference does not necessarily set forth that it is not visible under normal viewing conditions, only that it is not perceived sufficiently to decrease the usefulness of the document. Furthermore, the present invention specifically sets forth that the indicia is not capable of being scanned for reproduction. This simply means that the non-visible second indicia cannot be picked up by scanning so that it cannot be reproduced on another article. Thus, the scanner would not even realize that the second indicia is even there. This is in contrast to the Gasper et al. reference where the microdots are designed to be detected by the scanning device. In the present invention, the scanner doesn't even detect that the information is there whereas in the Gasper et al. reference, it is necessary to detect it in order to inhibit copying of the document.

Applicant respectfully submits that it is incumbent upon the Examiner to explain why one would take a hunting stamp and combine it with that of a media that restricts copying and which uses microdots. It is almost always possible to piecemeal reconstruct an invention, however, in the present instance, not only is there no teaching or suggestion to combine the features of the cited prior art, the prior art totally lacks teaching or providing first and second indicia as taught and claimed by Applicant. Accordingly, it is respectfully submitted that the claims in Group I are patentably distinct.

*Group II: Claims 19, 20, 21, 22, 30, 31, 32, 33*

B. These claims all depend upon independent claims 12 or 23. This group of claims include the limitations set forth in claims 19 and 30 which state that there is provided a third indicia for identifying a printer or location where the limited edition postal stamp was printed. In none of the prior art references is this limitation taught or suggested. Therefore, the prior art could not render obvious the present invention. These claims include specific limitations regarding the providing of a third indicia and the information associated with that third indicia. There is nothing in the prior art that teaches or suggests this and therefore these claims are clearly not taught or suggested by the prior art. Accordingly, it is respectfully submitted that these claims are also patentably distinct over the cited prior art.



### Summary

In summary, Applicant respectfully submit that the present invention is patentable over the cited prior art.

### Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims.

Respectfully submitted,



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Enclosures

### **Appendix I - Claims on Appeal**

1. Cancelled
2. Cancelled
3. Cancelled
4. Cancelled
5. Cancelled
6. Cancelled
7. Cancelled
8. Cancelled
9. Cancelled
10. Cancelled
11. Cancelled

12. (previously presented) A limited edition official postal stamp comprising:

a first indicia identifying said limited edition official postal stamp as being a limited edition, wherein said first indicia comprises a unique ID that identifies said limited indicia stamp as being one out of a predetermined number;

a second indicia which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp, said second indicia is not capable of being scanned for reproduction.

13. Cancelled

14. (previously presented) A limited edition official postal stamp according to claim 12 wherein said first indicia is visible.

15. Cancelled

16. Cancelled

17. Cancelled

18. (previously presented) A limited edition official postal stamp according to claim 12 wherein said second indicia is made using an ink that can be seen when viewed under UV or infrared light.

19. (previously presented) A limited edition official postal stamp according to claim 12 wherein a third indicia is provided for identifying a printer or a location where said limited edition official postal stamp was printed.

20. (previously presented) A limited edition official postal stamp according to claim 19 wherein said third indicia is not visible under normal viewing conditions.

21. (previously presented) A limited edition official postal stamp according to claim 20 wherein said third indicia is not capable of being scanned for reproduction.

22. (previously presented) A limited edition official postal stamp according to claim 21 wherein said third indicia is made using an ink that can be seen when viewed under UV or infrared light.

23. (previously presented) A sheet of limited edition official postal stamp, each stamp comprising:

a first indicia identifying said limited edition official postal stamp as being a limited edition, wherein said first indicia comprises a unique ID that identifies said limited indicia stamp as being one out of a predetermined number;

a second indicia which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid

limited edition official postal stamp, said second indicia is not capable of being scanned for reproduction.

24. Cancelled

25. (previously presented) A sheet of limited edition official postal stamps according to claim 23 wherein said first indicia is visible.

26. Cancelled

27. Cancelled

28. Cancelled

29. (previously presented) A sheet of limited edition official postal stamps according to claim 23 wherein said second indicia is made using an ink that can be seen when viewed under UV or infrared light.

30. (previously presented) A sheet of limited edition official postal stamps according to claim 23 wherein a third indicia is provided for identifying a printer or a location where said limited edition official postal stamp was printed.

31. (previously presented) A sheet of limited edition official postal stamps according to claim 30 wherein said third indicia is not visible under normal viewing conditions.

32. (previously presented) A sheet of limited edition official postal stamps according to claim 31 wherein said third indicia is not capable of being scanned for reproduction.

33. (previously presented) A sheet of limited edition official postal stamps according to claim 32 wherein said third indicia is made using an ink that can be seen when viewed under UV or infrared light.

34. (previously presented) A limited edition official postal stamp comprising:

a first indicia identifying said limited edition official postal stamp as being a limited edition, wherein said first indicia comprises a unique ID;

a second indicia which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp, said second indicia is not capable of being scanned for reproduction.

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Exhibit A

# Webster's II

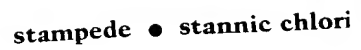
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ā pat   ā pay   ār care   ā father   ē pet   ē be   hw which   i pi  
i tie   ir pier   ō pot   ō toe   ō paw, for   oi noise   ōō took

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